



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,936	09/19/2003	Jack Chu	P1768 (MEDT/0024)	6819

28390 7590 05/31/2006
MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

KENNEDY, SHARON E

ART UNIT PAPER NUMBER

1615

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,936

Applicant(s)

CHU ET AL.

Examiner

Sharon E. Kennedy

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/2/04; 12/17/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action or the MPEP.

Claim Rejections - 35 USC § 102

Claims 1, 2, 5-9, 11-14, 16-18, 20-28, 30, 32-34, 36, 37, 39-44, 46, 47, 49, 53 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rosenbluth et al., US 2003/0014075 with reference to Hubbell et al., US 5,410,016, incorporated by reference in [0065]. See especially figure 3. Note is made that applicant's specification discloses that the carrier and reservoir may be the same device. See applicant's published [0027], line 14 of that paragraph. Regarding the biodegradable polymers, natural polymers, note Hubbell, incorporated by reference, discloses the biodegradable polymers. See especially all of column 8 of Hubbell. Regarding claim 9, see for example the disclosure of PVA in [0069]. Regarding claim 12, see embodiment figure 5a, pellets 160. Medications are listed, for example, in [0088]. Regarding claims 37+, the manner in which the device is not accorded much patentable weight. The claims should recite the structure necessary for the function.

Claims 1, 3, 4, 21, 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lax et al., US 2002/0065542. See especially figure 5, stent 510 and fill material 520. Note the explicit disclosure of the time release in [0046].

Claims 1, 2, 3, 4, 6, 15, 19, 21, 22, 31, 37, 38, 48, 49, 53, 54 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bose et al., US 6,666,882. Note especially the intra-aneurysmal occlusion devices. See also column 26 for a discussion

of the biodegradable polymers and bioactive materials. The time release aspect of the Bose device can be derived from the disclosure at column 26, lines 11-13. See also sheets 6 and 7.

Claims 37, 50-52 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Alps et al., US 5,733,871. Note especially the disclosure in Example 7, column 17. The osmotic pump was implanted subcutaneously in the back which a delivery tubing was installed into the brain. See also claim 4 and the diseases being treated. Regarding the stent of claim 52, again, applicant is claiming how the device is used instead of what it is. Since the stent is not positively recited, it is accorded little patentable weight.

Claim Rejections - 35 USC § 103

Claims 10, 29 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenbluth et al., US 2003/0014075. These claims recite the particular polymer. The examiner takes the position that it would be obvious to substitute one polymer for another in the manufacture of a medical device in the absent of a showing of criticality. Applicant's specification has been examined and there is no evidence of unexpected results from the use of these polymers. Accordingly, the claims are rejected.

Conclusion

Applicant should note that not all possible claim rejections have been applied. For example, the lack of a rejection of a claim in view of prior art is not an indication that the claim is allowable over that prior art. In addition, applicant should note that

Art Unit: 1615

numerous species have been presented and this application will likely be restricted at a future time period.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon E. Kennedy whose telephone number is 571/272-4948. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on 571/272-8373.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Sharon Kennedy". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Sharon E. Kennedy
Primary Examiner
Art Unit 1615